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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/691,525	10/24/2003	Anthony J. Presby	23708.00	7430
37833	7590	09/21/2005	EXAMINER	
LITMAN LAW OFFICES, LTD PO BOX 15035 CRYSTAL CITY STATION ARLINGTON, VA 22215			AVERY, BRIDGET D	
			ART UNIT	PAPER NUMBER
			3618	

DATE MAILED: 09/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/691,525

Applicant(s)

PRESBY, ANTHONY J.

Examiner

Bridget Avery

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 9 and 11-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 9 and 11-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The amendment filed by applicant on June 27, 2005 is acknowledged and has been entered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-5, 6, 9, 11 and 13-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bauer et al. (US Patent 5,582,430) in view of Finnson (US Patent 5,700,022).

Bauer et al. teaches a mud resistant/spray protection device and assembly for any type of vehicle (as taught in column 2, lines 49-55) fender/wheel cover, mudguard, splash guard or skirt, including: an air permeable liner dimensioned and configured for attachment to a lower surface of a vehicle fender/wheel cover, mudguard, splash guard or skirt; a backing material (18) capable of being attached to the lower surface of a motorcycle fender, as suggested in column 2, lines 49-57 and column 7, lines 15-17. The liner and backing material can be "bonded" using a first layer of adhesive, as suggested in column 4, lines 25-31. The liner is made of a flexible compressible material. Note, air can permeate through the pile fabric (10) forming the inlet layer (14) and the water passage openings (28) in the pile fabric (10). Bauer et al. further teaches

the liner can be made of thermoplastic mass injection-molded or applied in any other manner to the material web; projections formed by wire bristles, projections consisting of a textile material web such as any woven fabric, weft-knitted fabric, knitted fabric, fleece (also needle fleece of any desired textile material, of metal wire or of plastic fibers and/or plastic ribbons, as taught in column 2, lines 36-43 and column 3, lines 20-26. Bauer also teaches backing material including a woven mesh of monofilament fibers in the form of wire mesh, as taught in column 5, lines 23-36. Further note, the flexibility of the liner is clearly described in column 4, lines 1-24. It is old and well known that pile refers to the soft, resilient/compressible surface of fabric.

Bauer et al. lacks the teaching of a bead of sealant disposed around the edge of the liner/spray protection device. Bauer et al. lacks the teaching of attaching the liner/spray protection device to the wheel cover/fender using a second layer of adhesive bonding. Bauer et al. lacks the teaching of an open-cell material. Bauer et al. fails to disclose the thickness of the liner. Bauer et al. fails to disclose the exact position of the liner with respect to the lower edge of the wheel cover/fender.

Finnson teaches a heat seal (24) shown as a bead seal attaching the sheet (12) to the panel (14).

Based on the teachings of Finnson, it would have been obvious to one having ordinary skill in the art, at the time the invention was made, to modify the liner/spray protection device of Bauer et al. to include a heat/bead seal between the liner/spray protection device and the wheel cover/fender to form a weather-tight seal between the liner and fender to inhibit detachment of the liner. With respect to claims 15 and 17, it is

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the examiner's position that the method of forming a mud resistant liner/spray protection device on a vehicle including the steps of applying heat in order to raise the surface to a sufficient temperature to achieve a strong bond between the protective liner, the backing material, and the surface; and, the step of applying a bead of waterproof sealant around the protective liner and the backing material is obvious in view of Bauer et al. and Finnson to form a durable and long-lasting weatherproof seal and prevent unintentional detachment of the liner from the fender.

It would have been obvious to one having ordinary skill in the art, at the time the invention was made, to manufacture the liner of a synthetic material approximately one fourth of an inch thick, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. It would have been obvious to one having ordinary skill in the art, at the time the invention was made, to make the liner using an open-cell material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use. In this case, the use of an open-cell material would have been an obvious choice for durability and flexibility. It would have been obvious to one having ordinary skill in the art, at the time the invention was made, to connect the liner/spray protection device to the wheel cover/fender using a second layer of adhesive bonding, since Bauer et al. states at column 4, lines 27-29 that such a selection in connection process could depend on the materials used. The selection of a layer of adhesive bonding would be a cost effective means of connection to keep manufacturing cost low. It would have been obvious to

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one having ordinary skill in the art, at the time the invention was made to position the liner to extend to within approximately $\frac{1}{4}$ inch of a lower edge of the wheel cover/fender to protect a substantial portion of the wheel cover/fender. With respect to claims 13, 14 and 16, it is the examiner's position that the method of forming a mud resistant liner/spray protection device on a vehicle including the steps of preparing the surface for application of an adhesive by removing loose material from the surface and abrading the surface; applying a first layer of adhesive to the surface; firmly applying backing material to the first layer of adhesive, applying a second layer of adhesive to the backing material; firmly applying a layer of synthetic, air permeable material the second adhesive layer; and applying a roller to the air permeable material is obvious in view of Bauer et al. to reduce assembly time.

3. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bauer et al. ('430) in view of Dodt (US Patent 5,839,761).

Bauer teaches the features described above.

Bauer lacks the teaching of open-cell, polymeric, plastic, foam material.

Dodt teaches a lining including a layer made of open-pore plastic foam material.

Based on the teachings of Dodt, it would have been obvious to one having ordinary skill in the art, at the time the invention was made, to modify the assembly of Bauer et al. to include a layer of open-pore plastic foam material to reduce noise associated with traveling on roadways to enhance rider enjoyment.

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4. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wilson (US Patent 3,934,900) in view of Bauer et al. ('430) and Dodt (US Patent 5,839,761).

Wilson teaches a fender and splashguard attached to a motorcycle. The fender includes an upper surface and a concave lower surface.

Wilson lacks all other elements.

Bauer et al. teaches the mud resistant liner/spray protection device described above including a mesh backing.

Dodt teaches a lining including a layer made of open-pore plastic foam material.

Based on the teachings of Bauer et al., it would have been obvious to one having ordinary skill in the art, at the time the invention was made, to add a liner/spray protection device to the fender of Wilson to reduce the spray occurring behind a traveling vehicle and produced by wheels running on wet roads. It would have been obvious to one having ordinary skill in the art, at the time the invention was made, to connect the mesh backing to the fender using adhesive bonding and to connect the liner to the mesh backing using adhesive bonding, since Bauer et al. states at column 4, lines 27-29 that such a selection in connection process could depend on the materials used. The selection of an adhesive bonding would be a cost effective means of connection to keep manufacturing cost low.

Based on the teachings of Dodt, it would have been obvious to one having ordinary skill in the art, at the time the invention was made, to modify the fender assembly of Wilson and Bauer et al. to include a layer of open-pore plastic foam

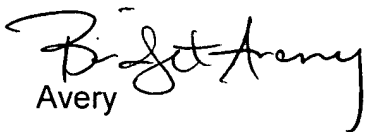
material to reduce noise associated with traveling on roadways to enhance rider enjoyment.

Conclusion

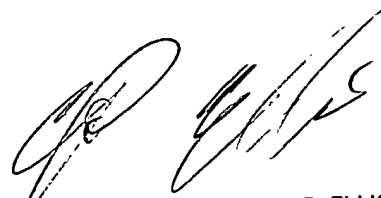
5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

6. Any inquiry concerning this communication should be directed to Bridget Avery at telephone number 571-272-6691.


Avery

September 15, 2005


CHRISTOPHER P. ELLIS
PRIMARY PATENT EXAMINER
TECHNOLOGY CENTER 3600